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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,935	01/02/2004	Philip S. Siegel	067439.0158	1902
5073 7590 11/19/2007 BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			EXAMINER SHAAWAT, MUSSA A	
			ART UNIT 3627	PAPER NUMBER
			NOTIFICATION DATE 11/19/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/750,935	SIEGEL, PHILIP S.	
	Examiner	Art Unit	
	Mussa A. Shaawat	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9,11-15,17 and 19-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9,11-15,17 and 19-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/14/2007</u> <u>102107</u> <u>m.s.</u> | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This communication is in response to the amendment filed on September 14, 2007. Claims 1, 15, 17, 19-22, 24, and 26-27 have been amended. Claims 3, 8, 10, 16 and 18 have been cancelled. Claims 1-2, 4-7, 9, 11-15, 17, and 19-27 are pending examination.
2. IDS submitted on September 14, 2007 have been considered.

Response to Arguments

3. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.
4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-2, 4-7, 9, 11-15, 17, and 19-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner found no support in the applicant specification for "on-line processing of merchandise returns for a plurality of merchants; Storing a set of return rules in a database for each of the plurality of merchants; in response to receiving the request from the customer, identifying a merchant associated with the at least one item of merchandise and identifying transaction information associated with the at least one item of merchandise;" recited in claim 1, 15, 17, 19, 20, 21-22, 24 and 26. In addition there is no support in applicant specification for "a logic embodied in a computer-readable medium and when executed operable to;" recited in claims 17, 21 and 26-27, **therefore the amendments to claims 17, 21 and 26-27 are not sufficient to overcome the 101 rejection and is maintained.** Correction is required by applicant

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 17, 21 and 26-27 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

Claim 17, 21 and 26-27 recite **computer product**, which do not fall within the four statutory classes of 101. Computer product is non-statutory subject matter unless embodied within a computer-readable storage medium such as computer hard disk or the like. Appropriate corrections are required to overcome the 101 rejections.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-2, 4-7, 9, 11-15, 17, and 19-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arganbright in view of Roman et al., US PG Pub. No. (US 2002/0010634 a1) and in further view of Lorenzen et al, US Patent No. (7,197,475) referred to hereinafter as Lorenzen.

11. Claim 1: Arganbright teaches a method of using a computer system for on-line processing of merchandise returns *for a plurality of merchants*, comprising the steps of: *Storing a set of return rules in a database for each of the plurality of merchants (see at least col.62 line 51-col.63 line 10, downloading (information is stored in a database or memory) satisfaction guarantees i.e. rules of returning a merchandise)*; receiving, via the Internet, a return request representing a request by a customer to initiate a return of

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at least one item of merchandise, (see col.63 8-11); and processing the return in accordance with the set of return rules associated with the merchant (see col.63 1-10, user reviews the satisfaction guarantee rules).

Arganbright does not expressly teach using the set of return rules associated with the identified merchant and the transaction information to validate the return; upon validating the return, electronically delivering data about the customer to the merchant associated with the return.

However, Roman teach using the set of return rules associated with the identified merchant and the transaction information to validate the return; upon validating the return, electronically delivering data about the customer to the merchant associated with the return (see at least Para [0021]-[0023]). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Roman into the disclosure of Arganbright in order to prevent the invalid return of merchandise.

In addition neither Arganbright nor Roman expressly teach plurality of merchants or identifying a merchant associated with the at least one item of merchandise. However, Lorenzen teaches identifying at least one item associated with at least one vendor or merchant, (see col.12 lines 24-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Lorenzen into the disclosure of Arganbright and Roman in order to enhance the flexibility of the consumer by giving the consumer more choices to choose from e.g. multiple vendors to select from.

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Claim 2: Arganbright teaches a method of claim 1, wherein the receiving step is performed via an Internet access tool associated with the customer, (see col.63 lines 5-8).

Claim 4: Arganbright does not expressly teach the step of determining whether the return is valid prior to the downloading step. However Roman teaches the step of determining whether the return is valid prior to the downloading step (see pp 0016 line 2 submitted return is analyzed for fraud against a database). It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Roman into the disclosure of Arganbright in order to prevent the invalid return of merchandise.

Claim 5: official notice is taken regarding the old and notorious practice of giving notice to customer that the request has been rejected and is made final.

Claim 6: Arganbright teaches a method of claim 1, wherein the processing step is performed by determining disposition of the item, (see col.63 lines 1-10).

Claim 7: Arganbright teaches a method of claim 1, wherein the processing step is performed by determining a shipping destination of the item, (see col.63 lines 29-31).

Claim 9: official notice is taken regarding the old and notorious practice of crediting an account of the customer.

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Claim 11: Arganbright teaches a method of claim 1, further comprising the step of providing a user interface to the customer, via an Internet access tool, wherein the user interface displays information associated with return of one or more items purchased by the customer, (see col.63 lines 1-11).

Claim 12: Arganbright teaches a method of claim 11, wherein the user interface displays a list of transactions associated with the customer, listing items for potential return by the customer, (see col.63 lines 1-11).

Claim 13: Arganbright teaches a method of claim 1, further comprising the step of downloading a return label to the customer via the Internet, (see col.63 lines 23-35).

Claim 14: Arganbright teaches a method of claim 1, further comprising the step of notifying a shipping agent of the return, (see col.63 lines 23-35).

Claim 25: Arganbright teaches a method of claim 24, wherein the system is further programmed to electronically provide the merchant with information about the customer, (see col.46 lines 35-53).

Claims 15, 17, 19-24, and 26-27, the limitations of claims 15, 17, 19-24, and 26-27 are similar to the limitations of claims 1 and 25, therefore claims 15, 17, 19-24, and 26-27 are rejected based on the same rationale.

Cited references

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to form 892 for cited references.

Contact Information

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mussa A. Shaawat whose telephone number is 571-272-2945. The examiner can normally be reached on Mon-Fri (8am-5:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mussa Shaawat
Patent Examiner
October 30, 2007

Michael Cuff 11/9/07
MICHAEL CUFF
PRIMARY EXAMINER